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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,587

03/19/2004

Alan G. Bunte

37955AAA

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7590

10/17/2005

John H. Sherman
c/o Legal Department
Intermec Technologies Corporation
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EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/804,587		BUNTE ET AL.	
	Examiner		Art Unit	
	Ahshik Kim		2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/1/05 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-26,30-61,63 and 64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-26 and 30-34 is/are allowed.
- 6) ☒ Claim(s) 35-61,63 and 64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on August 1, 2005. In the amendment
5 claims 2, 27-29, and 62 were canceled and claims 1, 3, 4, 6-8, 11, 16, 19, 35, 41, 50, 53, and 58
were amended. Currently, claims 1, 3-26, 30-61, 63, and 64 remain in the examination.

Obviousness-Type Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in
10 public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise
extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple
assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759
F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163
15 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome
an actual or provisional rejection based on a nonstatutory double patenting ground provided the
conflicting application or patent is shown to be commonly owned with this application. See 37
CFR 1.130(b).

20 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer.
A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 35-39, 41-43, 45-48, 50, 51, 53-61, 63, and 64 are rejected under the judicially
created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of
25 US Patent to Bunte et al. (US 6,330,975, hereinafter '975 patent)

Although the conflicting claims are not identical, it is the Examiner's view that they are
not patentably distinct from each other.

Amended claim 35 recites "An image capture system comprising: an optical reader
subsystem in a first configuration providing a coded image and in a second configuration
30 providing a photo image; a controller subsystem coupled to the optical reader subsystem for

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controlling the operation of the optical reader subsystem to capture coded images and photo images; and a light-energy sensor component, positioned to receive targeted coded information and photo image information; wherein the portable reader subsystem has a first optical path for capture of coded images, a second optical path for capture of photo images, and wherein both
5 optical paths lead to said light-energy sensor component.”

Amended claim 41 further limit “a light-energy sensor component, positioned to receive both targeted coded images and photo images.”

Amended claim 53 recites an image capture system further clarifying, in a broader manner than claim 35, first optical path and second optical path.

10 Amended claim 58 recites a method of operating an optical reader further clarifying first optical path and second optical path.

Claims 1-4 of ‘975 patent recites an image capturing system having the image capture module comprising: a first optical path for capturing coded images; and a second optical path for capturing photo images. In claim 1, the apparatus further discloses a decoding means. In claim
15 8, the apparatus is further comprised of a data transmitting means. In claim 12, the apparatus is further comprised of a display means and data buffer.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this
20 application. See 37 CFR 1.130(b).

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

5 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 35-61, 63, and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by Kinoshita (US 4,983,996, hereinafter “Kinoshita”).

10 Re claims 35-61, 63, and 64, Kinoshita discloses an image capture system comprising a camera subsystem 6, and a barcode reader subsystem 20 (col. 2, lines 26+). The optical system transfers the captured image to the control section to process (col. 2, lines 33+). Barcode reader being adjustably connected, they can be oriented in different field of view than the image capturing subsystem (see figure 1). As shown in figure 1, the camera and a barcode reader uses
15 two different optical paths; the camera uses a shutter 2; and the barcode reader uses a barcode scanner 20. The apparatus includes a decoder 36 (col. 4, lines 29+), indicating the captured image is of a quality allowing the image to be decoded. The camera, although not explicitly stated, would have a flash or other illumination means.

20 ***Allowable Subject Matter***

6. Claims 1, 3-26, and 30-34 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter: the claims are directed at an image capture system operable in a first mode and a second mode. The apparatus captures a coded image in a first mode and photo image information in a second mode.

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The optical paths in the first mode is different than in a second mode. Such an image capturing system is not disclosed or suggested by the cited references.

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Response to Arguments

8. Applicant's arguments filed on August 1, 2005 have been carefully reviewed and considered. Amended claims were carefully considered for a double patenting rejection against the claims of previously cited references to Bunte et al. (US 5,821,523, US 6,330,975). After
10 reviewing the double patenting rejection is withdrawn as the claims up to claim 34 were made allowable. Bunte references do not clearly disclose a first mode and a second mode of operation. It is the Examiner's view that the claims rejected under 35 USC 102 are disclosed by Kinoshita (US 4,983,996). Perhaps, some of the claims were rejected under Kinoshita instead of Sakaegi (US 6,040,856). However, these references are all disclosed in previous Office Action.

15 The amended claims and remarks describing these elements have been fully considered, but they are not persuasive, and therefore, the Examiner has made this Office Action final.

Conclusion

20 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Schaham (US 5,192,856); Watanabe et al. (US 4,853,733); Kazumi (US 5,343,267); Herzig et al. (US 6,594,503) disclose optical scanners. Applicant is respectfully suggested to carefully review these references.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Primary Examiner
Art Unit 2876
October 11, 2005

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